

REMARKS

Claims 79-105 and 108-117 are currently pending in this application. Claims 79-93 are allowed. Claims 116 and 117 stand objected to under 37 C.F.R. § 1.75(c). Claims 94-105 and 108-115 are rejected under 35 U.S.C. § 103(a) for obviousness over Schena et al. (PNAS 93:10614-10619, 1996; hereinafter “Schena”) in view of Komarova et al. (Oncogene 17:1089-1096, 1998; hereinafter “Komarova”). By this reply, Applicants cancel claims 108-112, amend claims 94-98, 101, 102, 109, 110, 116, and 117, and address the objections and rejection below.

Support for the Amendment

Claims 94-98, 101, 102, 109-110, 116, and 117 are amended to clarify the claimed subject matter. No new matter is added by the present amendment.

Objections to the Claims

Claims 116 and 117 are objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner states that “the recitation of ‘consists essentially of’ in claim 116 is interpreted as comprising because MPEP 2111.03 [R-3] states[,] ‘For the purposes of searching for and applying prior art under 35 U.S.C. § 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, ‘consisting essentially of’ will be construed as equivalent to comprising” (Office action, page 3).

Applicants respectfully traverse this rejection. M.P.E.P. § 2111.03 is inapplicable to the determination of whether a claim is a proper dependent claim under 37 C.F.R. § 1.75(c). 37 C.F.R. § 1.75(c) states that a claim “may be presented in dependent form, referring back to and further limiting another claim or claims in the same application... [and] shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.” Proper dependent claims are defined in M.P.E.P. § 608.01(n)(III), which states:

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope. (Emphasis added.)

Thus, the test for a proper dependent claim is not whether the dependent claim has a different scope than the claim from which it depends, but rather, whether the dependent claim includes every limitation of the claim from which it depends. Applicants submit that claim 116 includes every limitation of claim 94 from which it depends, and thus, is a proper dependent claim. The objection to claim 116 under 37 C.F.R. § 1.75(c) should be withdrawn.

Turning to claim 117, the Examiner states that “claim 117 fails to further limit claim 94” (Office action, page 3). Applicants note that claim 94, the independent claim from which claim 117 depends, recites a support that “comprises marker nucleic acid molecules specific for all or a portion of one or more differentially spliced regions of one or more human genes expressed in a human cell which is undergoing or has undergone apoptosis.” Claim 117, like claim 116, includes every limitation of claim 94 and is a proper dependent claim under 37 C.F.R. § 1.75(c) for the reasons discussed above. Although a difference in scope is not the test for a proper dependent claim, Applicants note that claim 117 is narrower in scope than claim 94, as it recites a support that “comprises marker nucleic acid molecules specific for all or a portion of more than one differentially spliced region of one or more human genes expressed in a human cell which is undergoing or has undergone apoptosis.”

The objection to claim 117 under 37 C.F.R. § 1.75(c) should also be withdrawn.

Rejections under 35 U.S.C. § 103(a)

Claims 94-105 and 108-115 are rejected under 35 U.S.C. § 103(a) over Schena in view of Komarova. The Examiner states: “[i]t would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use the method and microarray as taught by Schena et al. to study apoptosis as an indicator of the toxicity of

compounds applied to cells as taught by Komarova et al. in order to have the efficiency of a chip based approach to study gene expression in humans” (p. 7, Office Action).

In response to the amendments and arguments submitted to the Office on December 26, 2007, the Examiner states: “Applicants’ instant claims do not require the detection of differentially spliced gene products... [and] do not require the probes be specific for only differentially spliced genes expressed” (Office action, page 8). Applicants have amended claim 94 to more clearly recite that the method involves an analysis or determination of the toxicity of a test compound that requires detecting hybridization between marker nucleic acid molecules specific for all or a portion of one or more differentially spliced regions of one or more human genes expressed in a human cell that is undergoing or has undergone apoptosis and nucleic acid probes from a mammalian cell contacted with the test compound. The present amendment distinguishes the method of present claims 94-105, 109-111, and 113-117 over Schena and Komarova because these publications only describe the detection of differential gene expression (i.e., whether a gene is expressed or not); neither describes detecting the expression of all or a portion of one or more differentially spliced regions of one or more human genes that are expressed in a human cell that is undergoing or has undergone apoptosis, as is required by the method of present claims 94-105, 109-111, and 113-117.

Because Schena and Komarova, either alone or in combination, fail to teach or suggest each and every limitation of present claims 94-105, 109-111, and 113-117, as is required to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the rejection of present claims 94-105 and 108-115 should be withdrawn.

CONCLUSION

Applicants submit that the claims are novel and inventive over the prior art and respectfully request favorable reconsideration of the present application. In particular, it is believed that the claims are in condition for allowance, and a notification to that effect is respectfully requested.

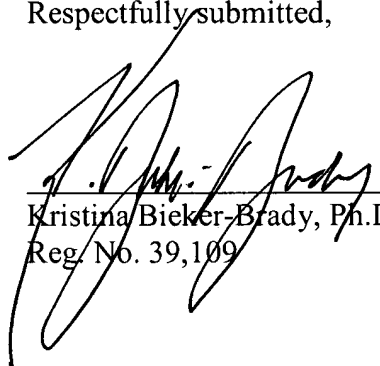
Enclosed is a petition to extend the period for replying to the Office action for two months, to and including July 11, 2008, and a check for the fee required under 37 C.F.R. § 1.17(a).

If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date:

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